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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/560,046	04/27/2000	David C. Greenspan	028870-224	2871

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EXAMINER

PAK, JOHN D

ART UNIT PAPER NUMBER

1616

DATE MAILED: 12/18/2001

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/560,046

Applicant(s)
Greenspan et al.

Examiner
Pak, J.

Art Unit
1616



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Sep 19, 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-49 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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Upon further review and reconsideration, the following new restriction requirement must be set forth. The previous election of species requirement was made *a priori*, before appreciating the distinctness that exists between inventive endeavor related to wound/burn/scar/inflammation and skin grafts. Additionally, distinctness of aqueous extracts of bioactive glass and “cosmetic products” language could not be fully appreciated until an attempt was made to sort out the prior art relevant to this application. *A posteriori*, it appears that multiple separate search and examination would have to be carried out to fully examine all the distinct inventions that are recited in the claims. Therefore, a new restriction requirement must be set forth hereinbelow.

MPEP 811.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 15-22, 24-37 and 48-49, drawn to composition, device, and method wherein wound, burn, scar tissue, inflammation or bacterial infection are treated with bioactive glass.
- II. Claims 13-14, drawn to method for grafting skin comprising applying bioactive glass to a graft site and/or donor tissue.
- III. Claims 38-40, drawn to an aqueous extract of small particles of bioactive glass.
- IV. Claims 41-47, drawn to cosmetic products containing particles of bioactive glass or aqueous extracts thereof.

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Applicant is further required to elect for examination purposes a single disclosed species of bioactive glass (i.e. elect one of the four groups and then further elect for examination purposes a single disclosed species of bioactive glass).

The four inventions are independent and/or distinct, each from the others, because they are each directed to separate subjects for inventive effort and are divergent in methods and composition makeup. The Examiner has made an attempt to examine together related subject matter (note that claims 15-22, 24-25 and 26-37, which could have been further separated out into additional groups, are kept together with claims 1-12). Skin grafting is clearly a separate subject for inventive effort, separate from the ordinary treatment of wounds, burns, scar tissue, inflammation and infection. An aqueous extract of bioactive glass is distinct over plain bioactive glass – unless there is a nexus type art, it is hard to imagine solid bioactive glass art, by itself, being suggestive of aqueous extract thereof. Cosmetic products of group IV run the gamut from women's cosmetic products to sun screens and other everyday products. Clearly applicant can appreciate that one bioactive glass search cannot possibly cover all the divergent inventive concepts embodied in groups I to IV. The Examiner would be forced to conduct four separate searches and essentially write four separate Office actions if the restriction were not required. Given the already broad scope of each of the inventions, a search and examination of just one of the inventions would be serious. To have to search and examine more than one of the inventions would place an undue burden on the Examiner, who is required to examine each application under

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a strict time requirement. Undue burden is defined in part by the parameters of the Examiner's resources.

Therefore, for the above stated reasons of distinctness and undue burden the restriction requirement is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

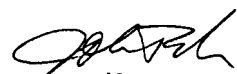
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machines are (703) 308-4556 or (703) 305-3592.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Examiner Pak whose telephone number is (703) 308-4538. The Examiner can normally be reached on Monday through Thursday from 8:00 AM to 5:30 PM. The Examiner can also be reached on alternate Fridays.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. José Dees, can be reached on (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.


JOHN PAK
PRIMARY EXAMINER
GROUP 1600